

### **REMARKS/ARGUMENTS**

This Amendment is submitted in response to the Office Action mailed December 8, 2009. At that time, claims 1-10, 12-22, and 24-30 were pending in the Application. Claims 1-5, 7, 13-22 and 24-28 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0183827 issued to Derus et al. (hereinafter "Derus"). Claims 6, 8-10, 12, 20-22, 24 and 29-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Derus.

By this Amendment, independent claims 1, 13 and 25, and dependent claims 4-5, 7, 12, 14-17, 19, 24 and 26-28 have been amended. Claims 2 and 3 have been canceled. New claim 31 has been added. Exemplary support for the amendments can be found in original claims 2 and 3 and paragraph [0021] of the specification. Exemplary support for new claim 31 can be found in original claim 1. Accordingly, claims 1, 4-10, 12-22 and 24-31 are presented for reconsideration by the Examiner.

#### **Claim Rejections under 35 U.S.C. § 102(b)**

Claims 1-5, 7, 13-22 and 24-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Derus. Claims 2 and 3 have been canceled, and claim 31 has been added. Claims 1, 4-5, 7, 13-17, 19 and 24-28 have herein been amended to more clearly emphasize the differences between the devices of Derus and the present application. The Applicants respectfully traverse this rejection.

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element as set forth in the claim must be found, expressly or inherently, in the prior art reference. See M.P.E.P. § 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1050, 1053 (Fed. Cir. 1987). For the reasons presented below, the Applicants assert that Derus does not disclose each and every element of independent claims 1, 13 and 25, and therefore cannot disclose the elements of dependent claims 4-5, 7, 14-22, 24 and 26-28.

**1. *The Derus Element (66) is Fixedly Attached to the Outer Tube (38), Not Coupled With the Inner Tube, and is Not a Stabilizing Member***

The Examiner has characterized the Derus device to disclose a stabilizing member (66), an outer tubular member (38), and an inner tubular member (40), in which the inner tubular member is “coupled with the stabilizing member” (see Office Action p. 2, 3rd paragraph, emphasis added). However, in the Derus device, the “outer tube 38 is fixedly attached to the forward loop handle 66 and thus moves axially forward and backward, over the inner tube 40, when the forward loop handle 66 is moved between the A and B positions” (see Derus, the last line of paragraph [0045], emphasis added). Claims 1, 13 and 25 of the present application state “the inner tubular member coupled with the stabilizing member.”

In addition, the Applicants respectfully assert that the forward loop handle (66) of Derus is not the stabilizing member of the present application, in that the stabilizing member of the present application comprises the grip portion of the handle, or support

member 400 (see present application, Fig. 1-3), which is coupled with the inner tubular member. In contrast, the loop handle 66 of Derus is fixedly attached to the outer tube 38 of the Derus device. For clarification, the support member portion of the stabilizing member has been more clearly defined in amended claims 1-4, 7, 13-16, 19 and 25-28.

## **2. *The Derus Element (68) is Not a Deployment Mechanism***

The Examiner has also characterized the Derus device to disclose a deployment mechanism comprising a release member (68) for moving the outer tubular member longitudinally relative to the inner tubular member without initially disengaging a safety mechanism. The Applicants respectfully assert that the release member (68) of Derus is not a deployment mechanism comprising a first and a second release member, as required by amended independent claims 1, 13 and 25 in the present application, for at least the reasons presented below.

As amended, independent claims 1, 13, and 25 state “the deployment mechanism comprising a first release member for at least partially moving the outer tubular member proximally and longitudinally relative to the inner tubular member from a first position to a second position, and a second release member operably connected to the first release member for moving the outer tubular member proximally and longitudinally relative to the inner tubular member from the second position to a third position.” The Derus device contains a hand piece 36 which “includes a safety catch release member 68 which is preferably integral with, and therefore moves with, the forward loop handle 66” (see Derus, paragraph [0046], first line, and Figs 5a and 5b).

The Derus element 68 does not comprise a first release member and a second release member for moving the outer tube member in the manner required by the claims of the present application.

In addition, the release member 68 of Derus is further described in paragraph [0046] as a “safety catch release member 68” which has a protuberance 72 that must be depressed to move the outer member distally from the main body 62 of the device. In contrast, the deployment mechanism in independent claims 13 and 25 of the present application comprises a release mechanism that acts “without initially disengaging a safety mechanism.”

### **3.     *The Derus Element (72) is Not a Second Release Member***

The Examiner has described the Derus device to disclose a second release member (72) that is operably connected to the first release member (see p. 2, 4th paragraph, Office Action). The Applicants assert the protuberance 72 of Derus is not a second release member in the manner claimed in the present application.

The safety catch release member 68 of Derus has a protuberance 72 that is depressed by a physician to unlock forward handle 66 (see Derus, paragraph [0046] and Fig. 5a). Thus, the protuberance 72 is a lock mechanism for releasing forward handle 66, but it is not “a second release member operably connected to the first release member for moving the outer tubular member proximally and longitudinally relative to the inner tubular member from the second position to a third position”, as required by the independent claims of the present application.

For the reasons stated above, the Applicants assert that Derus does not disclose each and every element of amended independent claims 1, 13 and 25, and therefore do not disclose the elements of amended dependent claims 4-5, 7, 15-22, 24 and 26-28. The Applicants respectfully submit that these claims define patentable subject matter, and therefore request that this rejection be withdrawn.

#### **Claim Rejections under 35 U.S.C. § 103(a)**

Claims 6, 8-10, 12, 20-22, 24 and 29-30 are rejected for obviousness under 35 U.S.C. §103(a). The Applicants note that independent claims 1, 13 and 25, from which claims 6, 8-10, 12, 20-22, 24 and 29-30 depend, have been herein amended. The Applicants respectfully traverse this rejection.

According to M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

As a result of this paper, claims 1, 13 and 25 include the limitation that both a first and a second release member are required in a deployment mechanism for moving the outer tubular member proximally and longitudinally relative to the inner tubular member from a first or second position to a second or third position. This limitation is not taught or disclosed by Derus, as discussed above. Therefore, Derus does not render claims 6,

8-10, 12, 20-22, 24 and 29-30 *prima facie* obvious under 35 U.S.C. § 103(a), and Applicants request that this rejection be withdrawn.

### **CONCLUSION**

The Applicants respectfully assert that claims 1, 4-10, 12-22 and 24-31 are patentably distinct from the cited reference, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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